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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,627	10/23/2003	Takaaki Sasaki	PNET.011D3	5930
7590 03/11/2005 VOLENTINE FRANCOS, P.L.L.C. SUITE150 12200 SUNRISE VALLEY DRIVE RESTON, VA 20191			EXAMINER POTTER, ROY KARL	
			ART UNIT 2822	PAPER NUMBER

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,627

Applicant(s)

SASAKI, TAKAAKI

Examiner

Roy K. Potter

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-16 and 19-23 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 24 and 25 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it is replete with references to a hall instead of a hole. Correction is required. See MPEP § 608.01(b).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12 – 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,661,099. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 12 recites the same invention as claims 1 - 4 of the Patent, except for the external connecting terminals bonded to the second ends of the plurality of connection pattern through the resist. To connect connecting patterns to external terminals would have been obvious to one of ordinary skill in the art as this is the purpose of the connection pattern.

Claim 13 recites the same limitations as claim 2 of the Patent.

Claim 14 recites the same limitation as claim 3 of the Patent.

Claim 15 recites the same limitation as claim 4 of the Patent.

Claims 19 – 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 - 8 of U.S. Patent No. 6,661,099. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 19 recites the same limitations as claim 5 in the U.S. Patent, except for the plurality of external connecting terminals bonded to the second ends of the connecting patterns.

Claim 20 recites the same limitations as claim 6 of the U.S. Patent.

Claim 21 recites the same limitations as claim 7 of the U.S. Patent.

Claim 22 recites the same limitations as claim 8 of the U.S. Patent.

Claims 16 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6661099 in view of Fukotomi et al..

Fukotomi et al., U.S. Patent No. 6,268,684 discloses a board for mounting a semiconductor element. As shown in Figure 4, chip 1 is connected by a conductive pattern 2 to solder balls 5, located on insulation substrate 7.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use solder balls to provide external connection as Fukotomi shows that solder balls can be used for this purpose.

Allowable Subject Matter

Claims 17 –18 and 24 – 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not teach or suggest the height of the resin in relation to the height of the connecting patterns as recited in claims 17-18 and 24-25.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy K. Potter whose telephone number is 571 272 1842. The examiner can normally be reached on M-F.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roy K Potter
Primary Examiner
Art Unit 2822